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In re Application of :
TIRAMANI :
Application No. 10/653,523 :
Filed: September 2, 2003 :
Attorney Docket No. 286357-00004-1 :
:

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OFFICE OF PETITIONS

**DECISION
ON PETITION**

This is a decision on the petition under 37 CFR 1.137(b), filed August 31, 2005, to revive the above-identified application.

The petition is **GRANTED**.

On September 2, 2003, Applicant filed the above-identified application and a non-publication request. On September 24, 2003, a Canadian Patent Application No. 2,442,403 (hereafter CA '403) was filed addressing a similar invention to the above-identified application. CA '403 was laid open to public inspection on March 24, 2005. No rescission of the previous non-publication request or notice of the filing of the Canadian application was received at the U.S. Patent and Trademark Office (hereafter PTO) until August 31, 2005.

Petitioner requests clarification regarding whether the Applicant was required to provide notice to the PTO of the filing of CA '403 not later than forty-five (45) days after the date of the filing of the Canadian application as set forth in 35 USC 122(b)(2)(B)(iii). Petitioner asserts, under Canadian law¹, patent applications are required to be open to public inspection eighteen (18) months after filing and are *optionally* published.

Portions of 35 U.S.C. 122(b)(2) are quoted below:

¹ The pertinent Canadian law is:

10. (1) Subject to subsections (2) to (6) and section 20, all patents, applications for patent, and documents filed in connection with patents or applications for patents shall be open to public inspection at the Patent Office under such conditions as may be prescribed.

R.S., 1985, c. P-4, s. 10; R.S., 1985, c. 33 (3rd Supp.), s. 2; 1993, c. 15, s. 28

26.2 (2) The Commissioner may publish any document open to the inspection of the public under section 10[.]

R.S. 1985, c. 33 (3rd Supp.), s. 7.

(B)(i) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).

(ii) An applicant may rescind a request made under clause (i) at any time.

(iii) An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

Laid open applications in Canada are considered publications for purposes of 35 U.S.C. 122(b)(2)(B)(i). MPEP 2127 explains that “[w]hen the specification is not issued in printed form but is announced in an official journal and anyone can inspect or obtain copies, it is sufficiently accessible to the public to constitute a “publication” within the meaning of 35 U.S.C. 102(a) and (b).” See also *In re Wyer*, 210 USPQ 790 (CCPA 1981). MPEP 2128 further explains, “[a]n electronic publication, including an on-line database or Internet publication, is considered to be a “printed publication” within the meaning of 35 U.S.C. 102(a) and (b) provided the publication was accessible to persons concerned with the art to which the documents relates.”² CA ‘403 has been sufficiently accessible to the public since March 23, 2005 through an on-line database. See <http://patents1.ic.gc.ca/faq-e/html> and http://patents1.ic.gc.ca/details?patent_number=2442403. As such, anyone could inspect or obtain copies of CA ‘403’s specification as of March 23, 2005. Additionally, the announcement of CA ‘403 being laid open for public inspection is listed in the Canadian Patent Office Record. See page 61 of Vol. 133, No. 15, April 12 of the Canadian Patent Office Record and [http://napoleon.ic.gc.ca/cipo/patgazarc.nsf/v_arcedition_e/04-12-2005laidopen/\\$File/cdnlo.pdf?OpenElement](http://napoleon.ic.gc.ca/cipo/patgazarc.nsf/v_arcedition_e/04-12-2005laidopen/$File/cdnlo.pdf?OpenElement). Also when CA ‘403 was announced in the Canadian Patent Office Record, the March 24, 2005 date was given an INID code of 41, which further indicates the date the application was made available to the public by viewing. See the later website link and MPEP 901.05(b).I. Finally, Canadian applications are given a kind code (A) when laid open to the public and thus are considered a document or publication. See MPEP 901.04(a) and page 3.16.4 of <http://www.wipo.int/scit/en/standards/pdf/03-16-01.pdf>.

Based on the above discussion, CA ‘403 is a publication for purposes of 35 USC 122(b)(2)(B)(i) when it was laid open to the public on March 23, 2005. Applicant, therefore, had forty-five days from the Canadian filing date (September 24, 2003) to notify the PTO of the filing. Applicant

² Even though the phrase, “publication,” in MPEP 2127-2128 is being discussed in the context of 35 U.S.C. 102(a) and 102(b), publication has the same meaning in 35 U.S.C. 122(b)(2) since 35 U.S.C. 122(b) uses the same word, and this meaning has not been differently defined in 35 U.S.C. 122(b)(2).

did not notify the PTO within the proscribed period. Accordingly by operation of law, the application became abandoned on November 9, 2003. See 35 U.S.C. 122(b)(2)(B)(iii).

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the notice of the subsequently filed Canadian application; (2) the petition fee of \$750; and (3) the required statement of unintentional delay have been received. Accordingly, the notice of a subsequent filing of a foreign application directed to the invention disclosed in the above-identified application filed in the PTO within forty-five (45) days after the date of filing of the foreign application is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of February 23, 2006 accompanies this decision on petition.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-4787.

The application matter is also being forwarded to Group Art Unit 3635.


Denise Pothier
Petitions Examiner
Office of Petitions


Conferee: Brian Hearn

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request